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08/466,554	06/06/95	SEUBERT	15270-002120
SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.

08/466,554 06/06/95 SEUBERT

P 15270-002120  
DUFFY, P

EXAMINER

ART UNIT PAPER NUMBER

6.

18M2/0223  
TOWNSEND AND TOWNSEND KHOURIE AND CREW  
STEUART STREET TOWER  
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SAN FRANCISCO CA 94105

1806

DATE MAILED  
02/23/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

*for restriction/election  
purposes only*

☒ This application has been examined <sup>1</sup> ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 30 month(s), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____   |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-41 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☐ Claims \_\_\_\_\_ are rejected.

5. ☐ Claims \_\_\_\_\_ are objected to.

6. ☒ Claims 1-41 are subject to restriction or election requirement.

7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

BEST AVAILABLE COPY

Art Unit: 1806

### Part III DETAILED ACTION

#### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-19, drawn to methods for measuring A $\beta$  (x->41) and diagnosis of Alzheimer's disease, classified in Class 435, subclass 7.92.

Group II. Claims 20-22, drawn to an *in vivo* method for screening for compounds that alter the amount of A $\beta$  (x->41) in the CSF, classified in Class 424 , subclass 9+.

Group III. Claims 23-32 and 36-41, drawn to methods for measuring tau and A $\beta$  (x->41) for the diagnosis and monitoring of Alzheimer's disease and compositions therefore, classified in Class 435, subclass 7.92.

Group IV. Claims 33-35, drawn to drawn to an *in vivo* method for screening for compounds that alter the amount of A $\beta$  (x->41) and tau in the CSF, classified in Class 424, subclass 9+.

The inventions are distinct, each from the other because of the following reasons: the methods of Groups I, II, III, and IV, as delineated above are each separate and distinct each from the other because they require different reagents, have different method steps, and have different final outcomes. Moreover, the methods of Groups I and III are drawn to *in vitro* methods of detection whereas the methods of Groups II and IV are drawn to *in vivo* methods of screening. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, as

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shown by their different classification, restriction for examination purposes as indicated is proper.

2. A telephone call was made to John Storella on February 15, 1996 to request an oral election to the above restriction requirement, but did not result in an election being made.
3. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia A. Duffy, Ph.D. whose telephone number is (703) 305-7555. The examiner can normally be reached on Monday-Friday from 6:30 AM to 3:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode, can be reached at (703) 308-4311.

Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application should be directed may be submitted to Group 1800 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The FAX number for Art Unit 1806 is (703) 308-4065.

Patricia A. Duffy, Ph.D.  
February 19, 1996

  
PAULA K. HUTZEL  
PRIMARY EXAMINER  
GROUP 1800